

REMARKS

1. Introduction

This paper is in response to the Office Action of April 7, 2006. The due date for response extends to July 7, 2006. Applicants note with appreciation the finding of allowable subject matter in claims 11 and 13. However, Applicants desire to proceed with the remaining claims. As a result, certain claims have been amended. No new matter has been introduced by these amendments.

For example, Applicants have cancelled claim 10 and amended claim 11 to include the features of claim 10 in order to comport with the provisions of 35 USC section 112, second paragraph, and claim 11 is considered to define a method suitable for patent protection therefor. The amendments to claim 11 were not necessitated to overcome the prior art. Additionally, claim 13 was amended to include the features of claim 10 in order to comport with the provisions of 35 USC section 112, second paragraph, and claim 13 is considered to define a method suitable for patent protection therefor. The amendments to claim 13 were not necessitated to overcome the prior art. The dependency of claim 12 was changed to depend from claim 11 in order to comport with the provision of 35 USC section 112, second paragraph. Amendments to claim 15 were undertaken to ensure that the same comported with the provisions of 35 USC section 112 and were not made to overcome the prior art. Amendments were made to claim 16 to more clearly define the invention.

2. Amendment to the Specification

The paragraph on page 14 of the written specification was amended to more clearly describe the invention by correcting typographical errors. No new matter has been introduced by these amendments.

3. Objection to Claim 14

Claim 14 was rejected as allegedly including a feature lacking antecedent basis. Specifically, the term "container" recited in claim 14 was alleged not to have antecedent basis in claim 10 from which claim 14 depended. Claim 14 has been amended accordingly and is believed to comport with the practices and provisions of the United States Patent and Trademark Office.

4. Rejection of Claim 10

In the Office action claim 10 was rejected as allegedly being anticipated by United States patent number 6,862,681 to Cheston et al. As mentioned above, Applicants have cancelled claim 10, vitiating the rejection of claim 10.

5. Rejection of Claims 1 and 15

In the Office action claims 1 and 15 were rejected as allegedly being obvious over Cheston et al. in view of United States patent application publication 2002/0083367 to McBride et al. Applicant has amended claim 15 so that both claim 1 and claim 15 include the features of copying boot data from O/S inaccessible storage to O/S accessible storage and booting the system from the O/S accessible storage. Admitted was Cheston et al.'s failure to teach accessing boot up data in O/S accessible storage that has been copied from O/S inaccessible storage. It was tacitly admitted that Cheston et al. did not suggest these features by the Office action contending that there is suggestion to combine McBride et al. with Cheston et al. to render the claims obvious. Moreover, it becomes clear that Cheston et al. do not suggest copying boot up data from O/S inaccessible storage to O/S accessible storage, because the O/S is temporarily allowed access to the O/S inaccessible storage. See col. 7, lines 41-46. Cheston et al. advocate this technology to allow efficient recovery of a computer system without necessitating the use of removable storage media, e.g., external diskette backups. See col. 2, lines 40-49. Allowing selective access to boot up data contained in an otherwise O/S inaccessible storage renders unnecessary copying boot data to other storage that is continuously accessible by the O/S and booting therefrom.

Nonetheless, there is no suggestion to combine the teachings of McBride et al. with Cheston et al., because doing so would render a desired function of McBride et al. invention inoperable. McBride et al. makes clear that the invention disclosed is directed to a method and apparatus for restoring a computer system to a default factory image. See ¶ [0012]. To that end, McBride et al. teach having a dual-boot system. See ¶ [0033]. McBride et al. advocate booting the computer system employing either the main logical drive or from the recovery logical drive. See ¶ [0032]. As a result, the recovery logical drive is not described as being inaccessible by the operating system. This is opposite to the teachings of Applicants and Cheston et al. It is respectfully contended, therefore, that there is no suggestion to combine the teachings of McBride et al. with Cheston et al., because doing so would prevent McBride et al. from achieving the desired goal of making the recovery logical drive (back up data) always accessible to the operating system. Based upon the foregoing, Applicants

respectfully contend that a *prima facie* case of obviousness is not present with respect to claims 1 and 15.

6. Claims 1 and 16

In addition to the arguments set forth above, claim 1 and amended claim 16 recite additional features that define methods suitable for patent protection: copying boot up data from an O/S inaccessible container to an O/S accessible container, if boot up using the boot up data from O/S/ accessible container fails, and booting the computer system using the boot up data copied into the O/S accessible container from the O/S inaccessible container.

Applicants advocate this method in order to prevent contamination of backup boot data stored on a computer system. See, page 4, lines 1-3; page 9, lines 1-3. As a result, Applicants desire to have back up boot data available to the computer system that has a low risk of becoming infected with one or more viruses. See page 9, lines 3-6. To that end, the data is stored in a memory space that is not accessed by a computer's operating system (O/S).

As argued above, Cheston et al. did not suggest copying boot up data from O/S inaccessible storage to O/S accessible storage and then booting from the data copied into the O/S accessible storage, because Cheston et al. direct their invention to allowing efficient recovery of a computer system without necessitating the use of removable storage media, e.g., external diskette backups. See col. 2, lines 40-49. Although Cheston et al. recognize that infection by viruses is a concern, see column 2, lines 45-47, Cheston et al. address a manner in which to reduce the risk of infection from remote computer systems and are completely silent with respect to preventing contamination of infected boot data on a computer system on which the back up boot data is stored. See page 11, lines 15-18. As a result, Cheston et al. make clear that the system may be booted by selectively allowing access to an otherwise O/S inaccessible storage. Allowing selective access to boot up of the system from the data contained in otherwise O/S inaccessible storage renders unnecessary copying boot data to another container that is continuously accessible by the O/S and booting therefrom. Moreover, without recognizing Applicants problem of preventing contamination of back up boot data by viruses infecting boot data in O/S accessible storage, Cheston et al. do not suggest the claimed invention.

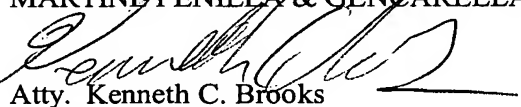
Moreover, combining the teachings of McBride et al. with the teachings of Cheston et al. do not render the claimed invention obvious, because the combination do not teach or suggest copying boot up data from an O/S inaccessible container to an O/S accessible container, if boot up using the boot up data from O/S/ accessible container fails, and booting the computer system using the boot up data copied into the O/S accessible container from the

O/S inaccessible container. As stated above, Cheston et al. do not suggest copying boot up data from an O/S inaccessible storage to O/S accessible storage. McBride et al., on the other hand, do not teach O/S inaccessible storage. As mentioned above, McBride et al. make clear that the invention disclosed is directed to a method and apparatus for restoring a computer system to a default factory image. See ¶ [0012]. To that end, McBride et al. teach having a dual-boot system and advocate booting the computer system employing either the main logical drive or from the recovery logical drive. See ¶¶ [0032] and [0033]. As a result, the recovery logical drive is not described as being inaccessible by the operating system, which is opposite to the teachings of Applicants. It is respectfully contended, therefore, that a *prima facie* case of obvious is not present with respect to claim 1 and amended claim 16.

7. Remaining Dependent Claims

Considering that the remaining dependent claims include all of the features of the independent claims from which they depend, the dependent claims are patentable to the extent that the independent claims are patentable. As a result, Applicant respectfully contends that a *prima facie* case of obviousness is not present with respect to the dependent claims for the reasons set forth above with respect to the independent claims from which they depend.

Therefore, Applicant respectfully request further examination in view of the amendments and remarks set forth above. A Notice of Allowance is earnestly solicited. If the Examiner has any questions concerning the present amendment, the Examiner is kindly requested to contact the undersigned at (408) 774-6910. If any other fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No ADAPP230). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,
MARTINE PENILLA & GENOARELLA, LLP

Atty. Kenneth C. Brooks
Reg. No. 38,393

710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085
Telephone: (408) 749-6900
Facsimile: (408) 749-6901